

Attorney Docket No.: **DEX-0054**
Inventors: **Robbins et al.**
Serial No.: **09/426,548**
Filing Date: **October 22, 1999**
Page 5

REMARKS

Claims 2, 3 and 9 are pending in the instant application. Claims 2 and 3 have been objected to. Claim 9 has been rejected. Claim 9 has been amended. Support for this amendment is found in the specification at pages 16, line 15 through page 17, line 16, page 17, line 34 through page 18, line 26, and page 18, line 32 through page 20, line 5 and in pending claims 2 and 3. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claim 9 under 35 U.S.C. § 112, second paragraph

Claim 9 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner suggests that the metes and bounds of claim 9 is unclear because the specific probe or nature of the complementary sequence of the probe is not clearly set forth in the claim. In particular, the Examiner suggests that it is unclear from the term complementary whether the probe comprises a single base pair or a larger probe which hybridizes or is capable of recognizing sequences which comprise the hMLH1 and hMSH2 mutants.

Attorney Docket No.: DEX-0054
Inventors: Robbins et al.
Serial No.: 09/426,548
Filing Date: October 22, 1999
Page 6

Claims 2 and 3 were not included in this rejection as the Examiner has acknowledged these claims to more clearly set forth that binding of the probe is indicative of the presence of the specific hMLH1 and hMSH2 mutations. Specifically, the Examiner states that the functional limitations set forth definable properties of the probe set forth in claim 9.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 9 to include similar functional limitations to those set forth in claims 2 and 3. Specifically, claim 9 has been amended to state that the oligonucleotide probe is capable of binding to a DNA or RNA sample and indicating the presence of a hMLH1 mutant 1, hMSH2 mutant 1, hMSH2 mutant 2, or hMSH2 mutant 3 in the sample. Support for this amendment can be found in claims 2 and 3 and in the specification at pages 16, line 15 through page 17, line 16, page 17, line 34 through page 18, line 26, and page 18, line 32 through page 20, line 5. Thus, no new matter is added by this amendment.

Withdrawal of this rejection of claim 9 under 35 U.S.C. § 112, second paragraph is respectfully requested in light of this amendment.

Attorney Docket No.: **DEX-0054**
Inventors: **Robbins et al.**
Serial No.: **09/426,548**
Filing Date: **October 22, 1999**
Page 7

II. Rejection of Claim 9 under 35 U.S.C. § 102(b) and § 102(e)

The rejections of claim 9 under 35 U.S.C. § 102(b) as being anticipated by Weber et al. and under 35 U.S.C. § 102(e) as being anticipated by Liskay et al. have been maintained. This rejection was withdrawn, however, with respect to claims 2 and 3 because amendment of the claims to indicate that the probes were directed to a hMLH1 mutant 1, a hMSH2 mutant 1, a hMSH2 mutant 2, or a hMSH2 mutant 3 and that binding of the probe was indicative of the presence of the hMLH1 mutant 1, the hMSH2 mutant 1, the hMSH2 mutant 2, or the hMSH2 mutant 3 was acknowledged by the Examiner to obviate these rejections.

Accordingly, in an earnest effort to advance the prosecution of this case and to clearly distinguish the present invention from teachings such as Weber and Liskay, Applicants have amended claim 9 to contain similar language to claims 2 and 3 and to state that oligonucleotide probe is capable of binding to a DNA or RNA sample and is indicative of the presence of a hMLH1 mutant 1, hMSH2 mutant 1, hMSH2 mutant 2, or hMSH2 mutant 3 in the sample. Support for this amendment can be found in the specification at pages 16, line 15 through page 17, line 16, page 17, line 34 through page 18, line 26, and page 18, line 32

Attorney Docket No.: **DEX-0054**
Inventors: **Robbins et al.**
Serial No.: **09/426,548**
Filing Date: **October 22, 1999**
Page 8

through page 20, line 5 wherein methods for detecting these mutants with oligonucleotide probes which bind to these mutants are specifically set forth. Since neither Weber et al. nor Liskay et al. teaches oligonucleotide probes which bind to and detect these mutants, these references cannot anticipate claim as amended.

Withdrawal of these rejections under 35 U.S.C. § 102(b) and (e) is therefore respectfully requested.

III. Objection to Claims 2 and 3

Claims 2 and 3 have been objected to as depending on rejected claim 9. As discussed in Section I and II, however, claim 9 has been amended to overcome all rejections and is now believed to be in condition for allowance.

Accordingly, withdrawal of this objection to claims 2 and 3 is respectfully requested.

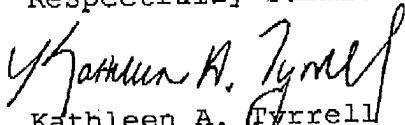
IV. Conclusion

Applicants believe the foregoing comprises a full and complete response to the Office Action of record. Accordingly,

Attorney Docket No.: DEX-0054
Inventors: Robbins et al.
Serial No.: 09/426,548
Filing Date: October 22, 1999
Page 9

favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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